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| APPLICATION NO.                      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/550,874                           | 09/27/2005  | Henrik Przybilla     | AT03 0014US1        | 1786             |
| 65913                                | 7590        | 04/30/2009           | EXAMINER            |                  |
| NXP, B.V.                            |             |                      | PATEL, NIRAV B      |                  |
| NXP INTELLECTUAL PROPERTY DEPARTMENT |             |                      | ART UNIT            | PAPER NUMBER     |
| M/S41-SJ                             |             |                      |                     | 2435             |
| 1109 MCKAY DRIVE                     |             |                      |                     |                  |
| SAN JOSE, CA 95131                   |             |                      |                     |                  |
| NOTIFICATION DATE                    |             | DELIVERY MODE        |                     |                  |
| 04/30/2009                           |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/550,874             | PRZYBILLA, HENRIK   |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | NIRAV PATEL            | 2435                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 September 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-17 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 27 September 2005 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/27/05</u> .   | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

1. This action is in response to the application filed on 09/27/05.
2. Claims 1-17 are under examination.

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 10, 11, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Richards et al. (US Patent No. 6,230,267).

As per claim 10, Richards teaches:

A data carrier for running at least one application, having at least one interface for the contactless and/or contact communication of information items [Fig. 1A, 11], and having computer means for running the at least one application, where information items communicated via the interfaces or information items stored in the data carrier are processed [Fig. 11, associated text], and having storage means for storing a first key information item and an associated data carrier identification information item that identifies the data carrier [Fig. 4, 11], and having checking means for checking a modification right of a modification device to modify an application in the data carrier via

the interface, where the checking means are designed to check the association of the first key information item stored in the storage means with the second key information item output to the data carrier by the modification devices, and having modification means which, following confirmation of the modification right of the modification device by the checking means, are designed to enable modification of the application in the data carrier by the modification device [Fig. 1A, 1B, 9, col. 10 lines 18-67, col. 11 lines 1-60].

As per claim 11, the rejection of claim 10 is incorporated and Richards teaches:

wherein the checking means are designed to confirm a restricted modification right which only gives the right to install and/or update and/or delete the application, in the data carriers [col. 11 lines 42-57].

As per claim 16, Richards teaches:

A modification device for modifying an application in a data carrier, having at least one interface for the contactless and/or contact communication of information items to a data carrier [Fig. 1A, 1B] identified by a data carrier identification information item, and having storage means for storing at least one data carrier identification information item that identifies a data carrier, and an associated second key information item [Fig. 1A, 1B, col. 6 lines 31-63, Fig. 5], and having computer means for modifying applications in data carriers via the interface where, in the course of communication with a data carrier identified by a stored data carrier identification information item, the modification right of

the modification device is output to the data carrier by communication of the second key information item associated with this data carrier identification information item, whereupon, following confirmation of the modification right by the data carrier, the modification device is authorized and designed to modify the application in the data carrier [Fig. 9, 10, col. 10 lines 17-67, col. 11 lines 1-59].

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everett et al. (U. S. Pub. No. 2002/0050528) and in view of Richards et al. (US Patent No. 6,230,267).

As per claim 1, Everett teaches:

A granting method to grant a modification device a modification right to modify an application in a data carrier [Fig. 9], wherein the following steps are carried out: generation of a first key information item and of an associated second key information item for one or more data carriers identified by a data carrier identification information

item [paragraph 0033, 0034, 0035, 0040, 0042, Fig. 3]; granting of the modification right for data carriers identified by the data carrier identification information item by outputting of the data carrier identification information item and of the associated second key information item to the modification device [paragraph 0055-0059]. Everett teaches checking the identification personalization data and if the result of check is positive, allowing of the modification of the application in the data carrier by the modification device [paragraph 0055-0059 Fig. 6, 7].

Richards teaches: checking of the association of the first key information item stored in the data carrier with the second key information item in the data carrier that was output to the data carrier by the modification device and, if the result of the check is positive; allowing of the modification of the application in the data carrier by the modification device [Fig. 1A, 1B, col. 8 lines 1-67, col. 9 lines 1-9, col. 11 lines 13-31, 42-46].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Richards with Everett, since one would have been motivated to provide secure transfer technique and to provide secure IC-card system that allows for the secure transfer of data to the intended IC card [Richards, col. 2 lines 30-42].

As per claim 2, the rejection of claim 1 is incorporated and Everett teaches:  
wherein the modification right gives the right to install and/or update and/or delete the application in the data carrier [paragraph 0055, 0025].

As per claim 3, the rejection of claim 1 is incorporated and Everett teaches:  
wherein the modification right only gives the right to modify a specific application in the data carriers [paragraph 0025, 0055, Fig. 6, 7].

As per claim 4, the rejection of claim 1 is incorporated and Everett teaches:  
wherein the modification right only gives the right to install an application requiring a predefined maximum amount of storage space in the data carrier [Fig. 7, paragraph 0061].

As per claim 5, the rejection of claim 1 is incorporated and Everett teaches:  
wherein the data carrier identification information item identifies a group of data carriers [paragraph 0040, 0008].

As per claim 6, the rejection of claim 1 is incorporated and Everett teaches:  
wherein the modification right also determines the access rights of the application that is to be modified in the data carrier to storage areas and interfaces of the data carriers [paragraph 0056, 0059, Fig. 6].

As per claim 7, the rejection of claim 1 is incorporated and Richards teaches:  
wherein the following further steps are carried out: generation of a first master key information item and of an associated second master key information item for one or

more data carriers identified by a data carrier identification information item, wherein the modification of access rights in the data carrier sand/or the generation of further key information items in the data carrier sand the modification device is possible only with the first master key information item stored in the data carrier and only with the second master key information item stored in the modification devices [col. 10 lines 20-48, Fig. 1A].

As per claim 8, the rejection of claim 7 is incorporated and Richards teaches:  
wherein the first master key information item and the associated second master key information item only make it possible to modify access rights of a specific application in the data carrier and/or to generate further key information items in the data carrier and the modification device in order to modify a specific application [col. 10 lines 20-48, Fig. 1A].

As per claim 9, the rejection of claim 1 is incorporated and Everett teaches:  
wherein modification of the application in the data carrier by the modification device of the data carrier is only permitted when specific properties of the application that is to be modified are determined paragraph 0055-0059].

5. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards et al. (US Patent No. 6,230,267) and in view of Everett et al. (U. S. Pub. No. 2002/0050528).

As per claim 12, the rejection of claim 10 is incorporated and Everett teaches:  
wherein the checking means are designed to confirm a restricted modification right which only gives the right to modify a specific application in the data carrier [paragraph 0025, 0055, Fig. 6, 7].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Everett with Richards, since one would have been motivated to protect against the improper or undesired loading of application onto IC cards and to provide secure IC-card system that allows for selective availability of smart card applications which may be loaded onto IC cards [Everett, paragraph 0006, 0007].

As per claim 13, the rejection of claim 10 is incorporated and Everett teaches:  
the checking means are designed to confirm a restricted modification right which only gives the right to install an application requiring a predefined maximum amount of storage space in the data carrier [Fig. 7, paragraph 0061].

As per claim 14, the rejection of claim 10 is incorporated and Everett teaches:  
wherein the checking means are designed to confirm a modification right which determines the access rights of the application that is to be modified in the data carrier

to storage areas of the storage means and interfaces of the data carrier [paragraph 0055-0059].

As per claim 15, the rejection of claim 10 is incorporated and Richards teaches the computer means are designed to run an application [Fig. 11, 111- control logic]. Richards doesn't expressively mention Java applet. Examiner takes official notice that the Java applet loaded onto the data carrier (smart card) were well known at the time the invention was made. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to utilize the Java applet for the smart card was well known.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richards et al. (US Patent No. 6,230,267) and in view of Ishiguro et al (US Patent No. 5,502765).

As per claim 17, the rejection of claim 16 is incorporated and Ishiguro teaches the modification device is formed by an operator computer containing the storage means and by a reading device that is connected to the operator computer over a data network, the reading device comprising the at least one interface and at least part of the computer means of the modification devices [Fig. 2].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Ishiguro with Richards, since one would have been motivated to protect against the improper or undesired loading of application onto IC

cards and to provide secure IC-card system that allows for selective availability of smart card applications which may be loaded onto IC cards [Everett, paragraph 0006, 0007].

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

de Jong (US 7232073) - -Smart card with multiple applications

Wentker et al (US 2002/0040936) – Delegated management of smart card applications

Matsui et al (US 2003/0105969) – Card system, method for installing an application in a card, and method for confirming application execution

Tanabiki et al (US 6834799) - - IC card with capability of having plurality of card managers installed

Kusakabe et al (US 7150039) – Information processing system, portable electronic device, access apparatus for the portable electronic device and method of using memory space

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIRAV PATEL whose telephone number is (571)272-5936. The examiner can normally be reached on 8 am - 4:30 pm (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. P./

*Examiner, Art Unit 2435*

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435